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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,730	01/08/2002	Mie Takahashi	2001-1464A	5291
513 7590 01/22/2009 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
COUNTS, GARY W				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/937,730

**Applicant(s)**

TAKAHASHI ET AL.

**Examiner**

GARY W. COUNTS

**Art Unit**

1641

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5, 12, 27, 31, 41, 45, 49, 53 and 60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 12, 27, 31, 41, 45, 49, 53 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/08 has been entered.
2. Claims 5, 12, 27, 31, 41, 45, 49, 53, and 60 have been amended. Currently, claims 5, 12, 27, 31, 41, 45, 49, 53, and 60 are pending and are under examination.

### **Withdrawn Rejections**

3. All rejections of claims not reiterated herein, have been withdrawn.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 5, 12, 27, 31, 41, 45, 53 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (US 6,284,194) in view of Shigehiro (JP11258239) (English computer translation provided).

Chu discloses an analytical device and method of making the device. Chu teaches that the device comprises a porous reaction membrane and at least one receptor immobilized in a limited region (col 1, lines 40-50) (reaction layer and reactive components). Chu teaches applying a surfactant (surface active agent) to the reaction membrane and allowing to dry (col 1, lines 55-67). Chu teaches that drying can be

performed by air drying at room temperature or by warm air with good ventilation (col 9, lines 30-43). Chu teaches the surfactant can be a non-ionic surface active agent (col 8) Chu teaches that all (entire) or most (part) of the surface (col 5, lines 27-32, col 9) is exposed to the surfactant.

Chu differs from the instant invention in failing to teach the surface active agent comprises a surface active agent having sugar in a hydrophilic part.

Shigehiro discloses immunoassays and teaches the addition of a non-ionic surface active agent having a disaccharide chain at a hydrophilic part to a reagent for the immunoassay (abstract) (para 0003—0006). Shigehiro teaches that the surface active agent is added to an immobilized receptor (para 0004, 0005). Shieghiro teaches that the addition of this surface active agent provides for improved assay sensitivity and also provides for increasing only a specific reaction (e.g. abstract, para. 0006)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate surface active agents such as taught by Shigehiro into the analytical device and method of Chu because Chu specifically teaches that non-ionic surfactants can be used and Shigehiro teaches that the addition of surface active agents having a disaccharide chain at a hydrophilic part provides for improved assay sensitivity and also provides for increasing only a specific reaction.

With respect to claims 41 and 45 as recited in the instant claims. Chu teaches that drying can be performed by warm air in good ventilation. Therefore, Chu teaches drying by moving air (wind) and thus Chu teaches wind drying as recited in the instant claims.

8. Claims 5, 12, 27, 31, 41, 45, 53 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jobling et al (US 6,130,100) in view of Shigehiro (JP11258239) (English computer translation provided).

Jobling et al disclose test strips and a process of manufacturing test strips (abstract and col 2, lines 31-67). Jobling et al disclose that the strip comprises a porous material which comprises a test zone (reactive layer) having immobilized specific binding reagents (reactive components) (col 2, lines 31-67 and col 3, lines 21-26). Jobling et al discloses that a solution comprising Tween 20 (surfactant, surface active agent) is applied to the porous strip and dried (col 6, lines 1-29). Jobling et al teaches that the drying step is performed by air drying. (col 6, lines 27-29). Jobling et al teaches that the solution migrates from one end of the strip to the other end (col 6 and Figures 1-3b). Therefore, Jobling teaches the entire reactive layer is impregnated with the surface active agent.

Shigehiro discloses immunoassays and teaches the addition of a non-ionic surface active agent having a disaccharide chain at a hydrophilic part to a reagent for the immunoassay (abstract) (para 0003—0006). Shigehiro teaches that the surface active agent is added to an immobilized receptor (para 0004, 0005). Shigehiro teaches that the addition of this surface active agent provides for improved assay sensitivity and also provides for increasing only a specific reaction (e.g. abstract, para. 0006)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate surface active agents such as taught by Shigehiro into the method of Jobling et al because Jobling et al specifically teaches that

surfactants are added and Shigehiro teaches that the addition of surface active agents having a disaccharide chain at a hydrophilic part provides for improved assay sensitivity and also provides for increasing only a specific reaction.

9. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chu or Jobling et al in view of Shigehiro as applied to claims 5, 12, 27, 31, 41, 45, 53 and 60 and further in view of Iwata et al (US 5,912,139).

See above for teachings of Chu, Jobling et al and Shigehiro.

Chu, Jobling et al and Shigehiro differ from the instant invention in failing to teach the reactive layer is dried by freeze drying.

Iwata et al disclose producing a test strip by impregnating a carrier with a solution comprising components. Iwata et al disclose that the impregnated carrier is then dried by freeze drying (col 6, lines 48-59). The components can be surfactants (col 6, lines 3-14 and col 10, lines 10-22). Freeze drying thoroughly removes water from the carrier (col 6, line 53). Iwata et al disclose that this provides for a test strip, which provides high sensitivity and high accuracy measurement and excellent storage stability (abstract & col 2, lines 22-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate freeze drying as taught by Iwata et al into the modified method of Chu because Iwata et al teaches that freeze drying thoroughly removes water from the carrier and Iwata et al also teaches that this provides for a test strip which provides high sensitivity and high accuracy measurement and excellent storage stability.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to incorporate freeze drying as taught by Iwata et al into the modified method of Jobling et al because Iwata et al teaches that freeze drying thoroughly removes water from the carrier and Iwata et al also teaches that this provides for a test strip which provides high sensitivity and high accuracy measurement and excellent storage stability.

### ***Response to Arguments***

10. Applicant's arguments filed 10/22/08 and the Declaration filed 12/17/08 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY W. COUNTS whose telephone number is (571)272-0817. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on (571) 272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Gary W. Counts/  
Examiner, Art Unit 1641

/GAILENE R. GABEL/  
Primary Examiner, Art Unit 1641